



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,989	03/03/2000	Charles R. Piskoti	IB-1366	6379

7590 06/16/2004
Henry P Sartorio
Lawrence Berkeley Nat'l Lab Patent Dept
One Cyclotron Road MS 90 1121
Berkeley, CA 94720

EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
----------	--------------

1754

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 06102004

Application Number: 09/518,989
Filing Date: March 03, 2000
Appellant(s): PISKOTI ET AL.

David Aston
For Appellant

EXAMINER'S ANSWER

MAILED
JUN 15 2004
GROUP 1700

This is in response to the appeal brief filed 3/15/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Due to the withdrawal of certain rejections, claims 1-5, 10 are on appeal. Claims 6-9 are considered allowed.

(4) Status of Amendments After Final

The statement in the Brief is correct.

Art Unit: 1754

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The sole issue is whether claims 1-5, 10 are patentable over Stankevich et al. Note that there is one rejection, not two, over Stankevich. The rejections under '112 first paragraph and over Service/Nature article are withdrawn.

(7) Grouping of Claims

Appellant's brief includes a statement that claims under appeal do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Stankevich et al., 'Polyhedral Carbon Clusters C_{36+12n} ($n>0$) And Their Hydrocarbon Analogs As Predecessors of (6,0)- Tubular Structures' in Molecular Materials vol. 10 pp. 169-174 (1998).

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 10 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stankevich et al.

The reference teaches C_{36} on pg. 172. As its properties are reported, it appears to have been made and isolated.

Art Unit: 1754

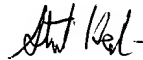
(11) Response to Argument

The argument that Stankevich is theoretical is not persuasive, as some experimental work is described. At the bottom of pg. 171 is noted some actual physical uses, although not for C36 explicitly. It is not seen how the calculations shown in the article could arrive at the physical properties quoted, thus it appears that C36 was characterized, and thus synthesized. That Stankevich does not detail the synthesis method is not persuasive.

It is noted that a 'coating' does not impart any additional limitation; it appears to be merely a statement of intended use.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



STUART L. HENDRICKSON
PRIMARY EXAMINER

SLH
June 11, 2004

Conferees

Henry P Sartorio
Lawrence Berkeley Nat'l Lab Patent Dept
One Cyclotron Road MS 90 1121
Berkeley, CA 94720

APPEAL CONFEREES:



DOUGLAS MCGINTY
QUALITY ASSURANCE SPECIALIST
TECHNOLOGY CENTER 1700